

REMARKS

By the above amendments, Claims 1-17 have been cancelled, new Claims 18-22 have been added. No new matter has been introduced by way of the amendments. Favorable reconsideration of this application is respectfully requested in view of the amendments above and the following remarks.

Drawings

The drawings were objected to for failing to show every feature of the invention specified in the claims. More specifically, the originally filed Claims 3 and 14 recite a "mechanical means coupled thereto for operating the printhead," which is not shown in the drawings. By the amendments above, Claims 3 and 14 have been cancelled, and new claims 18-22 do not recite such "mechanical means." Accordingly, withdrawal of the objection to the drawings is requested.

Specification

The disclosure was objected to because the specification lacks a reference numeral for the "mechanical means coupled thereto for operating the printhead" as recited in the originally filed Claims 3 and 14. As discussed above, this mechanical means is not being claimed and it is unnecessary to amend the drawings. Accordingly, correction to the specification is also deemed unnecessary.

Claim Rejection Under 35 U.S.C. §102

The test for determining if a reference anticipates a claim, for the purpose of a rejection under 35 U.S.C. §102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485

(Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. §102, the Court stated:

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

Claims 1, 2, 4-6, 12, 13 and 15-17 were rejected under U.S.C. §102(b) as being anticipated by Blackman et al ("Blackman") (US Pat. No. 6,029,020).

However, these claims have been cancelled and replaced by new Claims 18-22. It is submitted that Blackman does not disclose each and every element recited in the new independent Claim 18. More particularly, Blackman fails to disclose an output-roller assembly positioned downstream from the printhead and "a duplex path entry that is positioned adjacent to the output-roller assembly but downstream from the printhead so as to enable a trailing edge of the media sheet to enter the duplex media path" (emphasis added).

Claims 1, 3 and 5 were rejected under U.S.C. §102(b) as being anticipated by Stemmler (US Pat. No. 5,042,791).

However, these claims have been cancelled and replaced by new Claims 18-22. It is submitted that Stemmler does not disclose each and every element recited in the new independent Claim 18. For one thing, Stemmler does not disclose an inkjet printer having a printhead. Instead, Stemmler discloses an electrostatographic reproducing machine that requires an image transfer belt 14 to transfer image onto a media sheet. The cartridge 12 disclosed by Stemmler is not equivalent to a printhead of an inkjet printer. Secondly, the side shifting inverter 40 includes inversion mechanisms for inverting the media sheet several times about different axis before sending the media sheet back to the imaging section 41. By contrast, Claim 18 recites "a loop path for flipping the media sheet one time to thereby enable printing on a second side of the media sheet, wherein

said loop path has an entry portion for receiving the media sheet from the front duplex module and an exit portion that is aligned to the simplex media path” (emphasis added). Furthermore, the duplex section/side shifting inverter 40 is not detachable from the simplex section.

Claims 1, 3 and 5 were rejected under U.S.C. §102(e) as being anticipated by Saito et al. (“Saito”) (US Pat. No. 7,055,820).

However, these claims have been cancelled and replaced by new Claims 18-22. It is submitted that Saito does not disclose each and every element recited in the new independent Claim 18 or dependent claims 19-22. For one thing, Saito does not disclose an inkjet printer having a printhead. Instead, Saito discloses an image forming apparatus that requires a photoreceptor drum (31) and a transferring device (35) for forming an image onto a media sheet.

Claim Rejection Under 35 U.S.C. §103

The test for determining if a claim is rendered obvious by one or more references for the purpose of a rejection under 35 U.S.C. § 103 is set forth in MPEP § 706.02(j):

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

Claims 12 and 14 were rejected under U.S.C. §103(a) as being unpatentable over Stemmler in view of Blackman.

Claims 12 and 14 have been cancelled and replaced by new claims 18-22. It is submitted that the combination of Stemmler and Blackman does not teach or suggest all of the claim limitations set forth in the new independent Claim 18 or dependent claims 19-22. As such, the combination of Stemmler and Blackman fails to support a prima facie case of obviousness regarding the subject matter of Claims 18-22.

Conclusion

For the foregoing reasons, withdrawal of the rejections of record is respectfully requested and allowance of the present application is earnestly solicited.

Date: February 22, 2007

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Thi Dang', with a stylized, flowing script.

Thi Dang (Ms.)

Attorney for Applicants

Reg. No.: 53,877

Tel. No.: (202) 378-2572

Please send all correspondence to:
Hewlett-Packard Company
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400